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IN THE
Supreme Court of the United States
OCTOBER TERM, 1977

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No. 77-1040
—

HUGHES AIRCRAFT COMPANY,
Petitioner,
v.

BELL TELEPHONE LABORATORIES, INCORPORATED,
Respondent.

—
PETITIONER'S REPLY MEMORANDUM
—

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HUGHES AIRCRAFT COMPANY,
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BELL TELEPHONE LABORATORIES, INCORPORATED,
Respondent.

PETITIONER'S REPLY MEMORANDUM

Respondent's Brief in Opposition ("Resp. Brief") relies exclusively on repeated assertions that there are no valid issues of law or conflicts in the Circuits presented by this case. However, a newly published Court of Customs and Patent Appeals decision—which will be before this Court shortly on petition for a writ of certiorari—refutes Respondent's assertions. *See Naber v. Cricchi*, 567 F.2d 382 (C.C.P.A., Dec. 22, 1977), *petition for rehearing denied* (C.C.P.A., Feb. 23, 1978), *mandate stayed pending petition for writ of certiorari* (C.C.P.A., March 2, 1978) (copy attached hereto as Appendix A). Since the *Naber* decision is directly contrary to the Third Circuit's decision in the instant case, and since the two cases may be before this Court simultaneously,¹ Petitioner contends that a comparison of the two will demonstrate the important and recurring conflict in the lower courts on the first question presented by Hughes' Petition.

¹ The Court of Customs and Patent Appeals has stayed its mandate until April 1, 1978, in order for Appellee in *Naber* to file its Petition in this Court. Counsel for Appellee in *Naber* has informed the undersigned that he will be filing such a Petition.

Like the instant case, the *Naber* litigation is a patent interference proceeding² requiring judicial interpretation of the "reasonable diligence" standard in 35 U.S.C. § 102 (g). The Appellee ("Cricchi") in *Naber*, like Bell here, had been the first to conceive a new invention and, again like Bell, had delayed reducing his invention to practice until after Appellants ("Naber") had done so. The Board of Patent Interferences in *Naber*, like the District Court in the Hughes-Bell dispute, found that Cricchi's delay during a key four-month period was due to his work on certain "layer deposition techniques." Because this work was directed toward making the invention a "useful device," rather than a "mere laboratory device," the trial board concluded that "this work was required in order to reduce to practice" the invention and thus constituted "reasonable diligence" under 35 U.S.C. § 102(g). App. at 9a.³

In contrast to the Third Circuit in the instant case, however, the Court of Customs and Patent Appeals in *Naber* reversed as a matter of law, holding that the trial board had applied the wrong legal standard in making its findings. *Id.* at 9a-10a.⁴ The appellate court in *Naber* relied upon the rule that "there need not be commercial utility to have a reduction to practice." *Id.* at 9a. The court concluded that the "public policy favoring the early disclosure of inventions" requires courts to exclude from the efforts considered as "reasonable dili-

² The interference proceeding in *Naber*, as here, involves semiconductor devices used for integrated circuits.

³ The Appendix to this Reply Memorandum will be cited as "App. —." The Appendix to Hughes' Petition for a Writ of Certiorari will be cited as "Pet. App. —."

⁴ In addition to its holding on the reasonable diligence issue, the *Naber* court also considered the issue raised in the instant case relating to the type of evidence needed to corroborate an inventor's oral testimony. On this point, too, the Court of Customs and Patent Appeals took a different approach than the Third Circuit and ruled that time records prepared by the inventor himself were not sufficient corroboration of the inventor's oral testimony. App. at 10a-11a.

gence" any work which is "needed to produce a commercially acceptable device," but which is not necessary for reduction to practice. *Id.*

Although the board found that "this work was required in order to reduce to practice" the invention of the counts, both Cricchi and his supervisor admitted that a simple transistor embodying the structure embraced by the counts could have been built and tested for its memory characteristics. Cricchi chose not to proceed to a reduction to practice with a simple transistor, but to wait until work on layer deposition techniques progressed. Since he admittedly "possessed the capability of conducting such a test," it was his burden to reconcile the waiting period with the "reasonable diligence" requirement. * * *

The board found, and Cricchi contends, that the work on layer deposition techniques was required to produce a "useful device," rather than a "mere laboratory device." However, there need not be commercial utility to have a reduction to practice. * * * Acceptance of the proposition that the "reasonable diligence" requirement was satisfied, notwithstanding delay due to general work (on layer deposition techniques needed to produce a commercially-acceptable device), would, in effect, grant Cricchi a reservoir of "reasonable diligence" arising from work commenced prior to conception on October 22, 1969, and continuing into 1975. We are not persuaded that this accords with public policy favoring the early disclosure of inventions. [*Id.* at 8a-9a (footnotes and citations omitted).]

In the instant case, as in *Naber*, the District Court concluded that solution of the hysteresis problem, to which Bell's inventor "directed his efforts" in the Fall of 1966 (Pet. App. 11a), would contribute to the commercial usefulness of the invention, but was not necessary for "a successful reduction to practice." Pet. App. 16a. Nevertheless, directly contrary to the holding of the Court of

Customs and Patent Appeals in *Naber*, the lower courts here held that work on such matters *can* constitute reasonable diligence under 35 U.S.C. § 102(g). Pet. App. 19a n.19.

Bell has contended that the lower courts' "reasonable diligence" rulings are determinations of fact only, that they raise no legal issues, and that they therefore do not present any lower court conflict worthy of review by this Court. See Resp. Brief at 11-13. These contentions beg the question raised by Hughes. The District Court found *as a matter of fact* that the hysteresis problem "would not have precluded a successful reduction to practice." Pet. App. 16a. Nevertheless, over Hughes' repeated objections, the District Court then concluded *as a matter of law* that work directed toward such "problems inhibiting commercial utilization of the process should be deemed reasonable diligence." *Id.* at 19a n.19. The Third Circuit affirmed that holding, thus departing from the legal rule stated in *Naber*—as well as in the cases cited at pages 10-13 of Hughes' Petition—that proof of work aimed solely at enhancing the commercial utility of an invention, but not necessary to its reduction to practice, must be excluded *as a matter of law* from "reasonable diligence" consideration.

The District Court and Third Circuit rulings cannot be disposed of by labeling them mere "findings of fact." Hughes does not challenge any factual findings. The question presented here is the legal standard by which such factual findings, once made, are to be judged: may work affecting commercial utility, but unrelated to reduction to practice, be credited toward "reasonable diligence," or may it not? As we have shown, the Third Circuit has answered that legal question differently than *Naber* and other lower court decisions on the issue.

Moreover, it should be noted that the Court of Customs and Patent Appeals reached its final ruling in *Naber* only after Appellee had urged the court to follow the Third

Circuit's contrary holding in the instant case. See Petition for Rehearing at 8, *Naber v. Cricchi, supra*:

In *Bell Telephone Labs. v. Hughes Aircraft Co.*, 191 USPQ 23, 27, 30 (D. Del. 1976) diligence was found even though the inventor spent much time on a metallization step which was not included in the counts and elected to substitute an experimental metallizing step for a conventional step in the production of silicon-gate field effect transistors. The court specifically pointed out that (p. 31) "work on problems inhibiting commercial utilization of the process should be deemed reasonable diligence * * *."

Thus, despite Bell's repeated suggestions to this Court that no conflict or issue of law is presented by the instant case (e.g., Resp. Brief at 2, 3, 13), and despite Bell's lengthy but irrelevant recitation of evidence intended to convince the Court that this case simply raises factual issues (*id.* at 4-10), the *Naber* decision provides timely confirmation of the conflict between the Circuits on an important and frequently recurring legal issue that requires review by this Court.

Hughes believes that it already has anticipated and responded to the remaining arguments raised by Respondent, and wishes to add only the following brief points:

1. *There is a conflict between the Circuits on the standard for corroborative evidence.* Bell has argued that the cases cited at pages 17-19 of Hughes' Petition do not reveal any conflict between the Circuits on the standard for corroborative evidence, and that Hughes has sought "to create confusion by the use of labels." Resp. Brief at 14. Bell seeks to support this charge by referring to *Cleeton v. Hewlett-Packard Co.*, 343 F. Supp. 1215 (D. Md. 1972), one of the cases Hughes cited as illustrative of the "per se" rule. Bell claims that *Cleeton* actually "cited, and applied, the standard of Hughes' leading 'rule of reason' case, *Ritter v. Rohm & Haas*

Company, 271 F. Supp. 313 (S.D.N.Y. 1967)." Resp. Brief at 14 n.*. Bell's reference to the *Cleeton* decision is inaccurate and misleading. As Hughes showed in its Petition, the *Cleeton* court stated (with citations) that it follows the rule that an inventor's *own writings* cannot constitute the "necessary independent corroboration" required to support his oral testimony. *Cleeton v. Hewlett-Packard Co.*, *supra*, 343 F. Supp. at 1221. The *Cleeton* court went on, however, to note that "in other cases" courts have held that a "rule of reason" should determine whether an inventor's *own writings* are sufficient to corroborate his oral testimony. *Id.* It was in that context that the *Cleeton* decision, as Bell notes, cited *Ritter v. Rohm & Haas Co.* as an example of the *differing* "rule of reason" approach. Thus, contrary to Bell's suggestion, the *Cleeton* decision clearly supports Hughes' point that there is a conflict between the Circuits on this issue.

2. *There was no contemporaneous documentation of Bell's inventors' work.* Bell accuses Hughes of being "flatly wrong" in arguing that the lower courts allow Bell to corroborate its inventors' oral testimony with "non-contemporaneous documents prepared by the inventors themselves." Resp. Brief at 9 (emphasis in original). Bell then cites a string of evidence which it contends proves Hughes wrong. *Id.* That evidence, however, is irrelevant to Hughes' contention (see Petition at 19-20 & n.16), since, as Bell itself notes, the cited documents were written in November, December or January—not contemporaneously with the work done from October 17, 1966 to mid-November 1966, the key period for which the District Court noted there was an absence of contemporaneous documentation. Pet. App. 12a, 19a.

3. *Bell did destroy key documents.* In urging a new, stronger corroborative evidence rule, Hughes' Petition

* The *Cleeton* court concluded that even "assuming, *arguendo* only," it were to follow the *Ritter* rule, the result would be the same, given the facts of that case. 343 F. Supp. at 1222.

noted that prior to this litigation Bell had destroyed certain important documents relating to the "reasonable diligence" period. Petition at 22 & n.19. While Bell responds that nothing of substance was ever destroyed (Resp. Brief at 10), it simply ignores the fact that at trial its own counsel acknowledged—with "regret"—that "raw data" that presumably was recorded in dated laboratory notebooks had been destroyed prior to the start of this litigation. J.A. 242. Furthermore, that destruction occurred notwithstanding Bell's own internal policies requiring retention of laboratory notebooks for 30 years. Defendant's Exhibit 12. It is undisputed that Bell never offered any explanation of how or why it destroyed this key data.

* * * *

For all of the reasons set forth above, as well as those urged in its earlier Petition for a Writ of Certiorari, Petitioner respectfully urges this Court to grant certiorari in order to resolve the conflict in the lower courts concerning important principles of patent law.

Respectfully submitted,

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APPENDIX**UNITED STATES COURT OF CUSTOMS
AND PATENT APPEALS**

Appeal No. 77-556

CHARLES T. NABER and GEORGE C. LOCKWOOD,
Appellants,
v.

JAMES R. CRICCHI,
Appellee.

Dec. 22, 1977

In patent interference proceeding, appeal was taken from decision of the Board of Patent Interferences, Interference No. 98,566, awarding priority of invention to the junior party. The Court of Customs and Patent Appeals, Miller, J., held that: (1) with respect to an improved "drain-source-protected" metal-nitride-oxide-semiconductor device which could be used as a nonvolatile, electrically alterable memory element in various integrated circuits, work during particular period directed at improving oxide and nitride layer deposition techniques generally applicable to all metal-nitride-oxide-semiconductor devices and not merely the "drain-source-protected" device of the counts at issue did not satisfy the requirement of "reasonable diligence" on the part of the junior party with respect to reducing invention to practice, and (2) with respect to work after the forgoing period, junior party's uncorroborated testimony together

with time cards which were not self-explanatory could not satisfy the burden of showing "reasonable diligence."

Reversed.

1. Patents § 90(5)

In order to satisfy "reasonable diligence" requirement, work relied on must ordinarily be directly related to reduction to practice of the invention of the counts in issue; however, work in preparation for filing related patent applications may suffice, as may work required to develop a first invention in order to develop or reduce to practice a second invention. 35 U.S.C.A. § 102(g).

See publication Words and Phrases for other judicial constructions and definitions.

2. Patents § 90(5)

There need not be commercial utility to have a reduction to practice.

3. Patents § 90(5)

With respect to an improved "drain-source-protected" metal-nitride-oxide-semiconductor device which could be used as a nonvolatile, electrically alterable memory element in various integrated circuits, work during particular period directed at improving oxide and nitride layer deposition techniques generally applicable to all metal-nitride-oxide-semiconductor devices and not merely the "drain-source-protected" device of the counts at issue did not satisfy the requirement of "reasonable diligence" on the part of the junior party with respect to reducing invention to practice. 35 U.S.C.A. § 102(g).

4. Patents § 113(1)

Where issue was not raised in senior party's main brief before the Board of Patent Interferences but was raised in request for reconsideration and the Board considered

the argument in reaching its decision, issue was properly before court on appeal.

5. Patents § 91(4)

Junior party's uncorroborated testimony together with time cards which were not self-explanatory could not satisfy junior party's burden of showing "reasonable diligence" in reducing invention to practice, where junior party did not present any documentary evidence showing specific acts at specific times directed at a reduction to practice of the invention of the counts at issue and testimony of his own witnesses contradicted his allegation that time charged to the project numbers on the time cards was directed solely at a reduction to practice of such invention.

6. Patents § 113(6)

Where junior party argued issue of senior party's entry into the field before the Board of Patent Interferences, it was not necessary for him to file a cross appeal to preserve the issue for argument before court on senior party's appeal from award of priority to the junior party.

7. Patents § 113(1)

Where senior party did not question finding of date of its entry into the field, so that it would have been junior party who would have raised the issue if it were to be argued before the court on senior party's appeal from award of priority of invention to junior party, costs of printing, at request of junior party, portions of transcript relating to such issue would be assessed against junior party.

William J. Birmingham, Chicago, Ill., Attorney of record for appellant; Lowell C. Bergstedt, Dayton, Ohio, of counsel.

James B. Hinson, Pittsburgh, Pa., Attorney of record for appellee; Charles L. Menzemer, Pittsburgh, Pa., of counsel.

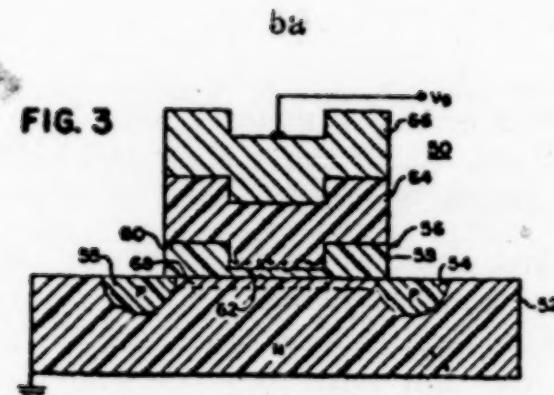
Before MARKEY, Chief Judge, and RICH, BALDWIN, LANE and MILLER, Judges.

MILLER, Judge.

This appeal is from the decision of the Patent and Trademark Office Board of Patent Interferences (board) awarding priority of invention of the counts in issue to the junior party, Cricchi. The counts were copied by Cricchi¹ from a patent to Naber et al. (Naber) No. 3,719,866, issued March 6, 1973, and entitled "Semiconductor Memory Device." The dispositive question, which the board decided in favor of Cricchi, is whether Cricchi was reasonably diligent from a time just prior to Naber's entry into the field (June 1970) until Cricchi's actual reduction to practice (September 1971). We reverse.

Subject Matter of the Counts

The invention is an improved "drain-source-protected" metal-nitride-oxide-semiconductor (MNOS) device which can be used as a nonvolatile, electrically alterable memory element in various integrated circuits. The specific improvement (illustrated by Figure 3 of the Naber patent) is that the silicon oxide layer (56) in the vicinity of the drain (54) and source (55) of the transistor is made thicker (shown at areas 58 and 60) than the corresponding layer in prior art devices.



All of the counts include a recitation of this structure. Count 1 is illustrative and reads as follows:

Count 1

A metal-nitride-oxide-semiconductor device comprising:

a semiconductor material substrate of one conductivity having a first and a second region of opposite conductivity extending therein, said first and second regions being separated by a channel region having a channel formed therein through which majority carriers can flow from said first region to said second region, said first, second, and channel regions all extending from one surface of said substrate;

a layer of oxide material affixed to said one surface of said substrate to interface with the junction of said first region-channel region, said channel region, and the junction of said channel region-second region, said oxide layer having a first thickness in the vicinity of said first region-channel region junction and in the vicinity of said channel region-second region junction and a second thickness there between;

a layer of nitride material affixed to said oxide material and spaced apart from said substrate by said oxide material; and

¹ In an amendment filed June 1, 1973, to his application serial No. 219,463, filed January 20, 1972, entitled "Enhancement Mode Limited MNOS Memory Device."

a layer of conductor material affixed to said nitride material and spaced apart from said oxide material by said nitride material;

said first thickness being of more than a charge tunnel thickness to prevent any charge from tunneling between said oxide material-nitride material interface and said substrate-oxide material interface and said second thickness being of less than a charge tunnel thickness to allow charge to tunnel between said oxide material-nitride material interface and said substrate-oxide material interface.

Proceedings Below

The Board found that Cricchi established conception of the subject matter of the counts on October 22, 1969, and concluded that the combined testimony of Cricchi's co-workers established—

that at the time Cricchi conceived of the device . . . improvements were necessary in deposition processes of the oxide and nitride layers and that efforts to improve on the processes were part of a continuous program which extended from prior to October of 1969 into October of 1970.²

The board also found that Cricchi Exhibit 100, consisting of copies of time cards for four project numbers, "indicates reasonably continuous activity charged to the project numbers . . . used to identify the programs for constructing and testing the MNOS transistor" embodying the counts in issue. The board was not persuaded by Naber's argument that experiments directed at improving layer deposition techniques generally did not satisfy the "reasonable diligence" requirement, not being directed at

² The program of improving deposition techniques was still going on in 1975 at Westinghouse, Cricchi's assignee.

construction and testing of the MNOS device of the counts. It said:

[T]his work was required in order to reduce to practice the transistor conceived by Cricchi on October 22, 1969. Dr. Corak [Cricchi's supervisor] testified that improvement in the method of deposition was required in order to produce a useful device rather than a mere laboratory device.

In the Request for Reconsideration, Naber argued that Cricchi was not reasonably diligent during the period from June to October 1970 since work done then was directed at improving layer deposition techniques generally; further, that Cricchi Exhibit 100 was not proof of diligence during the period from October 1970 to September 1971. The board adhered to its original decision.

OPINION

**1. Work on Layer Deposition Techniques
(June to October 1970)**

[1] The record shows that the work done at Westinghouse to improve oxide and nitride layer deposition techniques was generally applicable to all MNOS devices, not merely the "drain-source protected" device of the counts, and that this work had in fact commenced *prior* to Cricchi's conception of the invention. It is well settled that, to satisfy the "reasonable diligence" requirement of 35 U.S.C. § 102(g), the work relied on must ordinarily be directly related to reduction to practice of the invention of the counts in issue. *Anderson v. Scinta*, 372 F.2d 523, 54 CCPA 1269, 152 USPQ 584 (1967); *Martin v. Snyder*, 214 F.2d 177, 41 CCPA 1010, 102 USPQ 306 (1954); *Gunn v. Bosch*, 181 USPQ 757 (Bd.Pat.Int'f 1973); *Moore v. Harris v. Hale*, 92 USPQ 187 (Bd.Pat. Int'f 1951). However, work in preparation for filing related patent applications may suffice (e. g., *Rey-Bellet*

v. *Englehardt*, 493 F.2d 1380, 181 USPQ 453 (Cust. & Pat. App. 1974)), as may work required to develop a first invention in order to develop or reduce to practice a second invention (e. g., *Keizer v. Bradley*, 270 F.2d 396, 47 CCPA 709, 123 USPQ 215 (1959); *Thompson v. Dunn*, 166 F.2d 443, 35 CCPA 957, 77 USPQ 49 (1948)).

There is no evidence that Cricchi's layer deposition techniques work was in preparation for filing related patent applications or was required to develop a first invention needed to proceed with the invention of the counts. Although the board found that "this work was required in order to reduce to practice" the invention of the counts, both Cricchi and his supervisor admitted that a simple transistor embodying the structure embraced by the counts could have been built and tested for its memory characteristics.³ Cricchi chose not to proceed to a reduction to practice with a simple transistor, but to wait until work on layer deposition techniques progressed.⁴ Since he admittedly "possessed the capability of conducting such a test," it was his burden to reconcile the waiting period with the "reasonable diligence" requirement. *Litchfield v. Eigen*, 535 F.2d 72, 76, 190 USPQ 113, 116 (Cust. & Pat. App. 1976).⁵

³ Naber does not contend, nor would we agree, that Cricchi was under an absolute obligation to choose the simplest device embodying the structure of the counts to attempt a reduction to practice.

⁴ Cricchi's brief contains the statement: "The fact that the demonstration device might have been constructed without doing this work [the process development work relating to layer deposition techniques] has been clearly recognized by Cricchi during all phases of this case."

⁵ Public policy favors the early disclosure of inventions. This underlies the requirement for "reasonable diligence" in reducing an invention to practice, not unlike the requirement that, to avoid a holding of suppression or concealment, there be no unreasonable delay in filing an application once there has been a reduction to practice. See *Young v. Dworkin*, 489 F.2d 1277, 180 USPQ 388 (Cust. & Pat. App. 1974).

[2] The board found, and Cricchi contends, that the work on layer deposition techniques was required to produce a "useful device," rather than a "mere laboratory device." However, there need not be commercial utility to have a reduction to practice. As this court said in *Goodrich v. Harmsen*, 442 F.2d 377, 383, 58 CCPA 1144, 1153, 169 USPQ 553, 559 (1971): "In the nature of things, testing goes on throughout the process of 'commercializing' and often continues after a product is on the market where it usually receives its severest test." Acceptance of the proposition that the "reasonable diligence" requirement was satisfied, notwithstanding delay due to general work (on layer deposition techniques needed to produce a commercially-acceptable device), would, in effect, grant Cricchi a reservoir of "reasonable diligence" arising from work commenced prior to conception on October 22, 1969, and continuing into 1975. We are not persuaded that this accords with public policy favoring the early disclosure of inventions.

[3] Cricchi's reliance on *Justus v. Appenzeller*, 177 USPQ 332 (Bd.Pat.Int'l 1971), is misplaced. In that case, a reduction to practice of the counts required a "bearing means" which Justus ordered to be custom made. Unforeseen circumstances delayed delivery of the bearings, with resultant delay in Justus' reduction to practice. Such circumstances are not present here. Cricchi had the materials and capability in June 1970 to produce a working MNOS memory device of the counts.⁶

We hold that work done at Westinghouse during the period from June to October 1970 directed at improving oxide and nitride layer deposition techniques generally

⁶ On the record before us, the correctness of the board's conclusion, that such a device would have operated for only a "few hours" before failure, is questionable. In a proposal to the Air Force, Westinghouse indicated that it had developed an MNOS device early in 1969 that was operable for "greater than 1,000 hours."

applicable to all MNOS devices did not satisfy the requirement of "reasonable diligence" on the part of Cricchi.

2. Time Card Charges (October 1970 to September 1971)

[4] Naber argues that Cricchi's testimony concerning the work performed under the four project numbers covered by time card charges of record is uncorroborated and, thus, cannot be used to show diligence; also, that work done under the project numbers after October 1970 was not directed at reducing to practice the invention of the counts.⁷

We are satisfied that at least some work done after October 1970 and charged to the project numbers had nothing to do with reducing to practice the invention of the counts. Thus, one Westinghouse employee (a Cricchi witness) testified that he did not begin working on the "834 device" (a device embodying the count limitations) until May 1971; but his time card charges show work done under the project numbers before that date.⁸ This flatly contradicts testimony in the Cricchi record that if time was charged to the project numbers, the work being done was on the "834" project.

[5] Naber's argument that Cricchi's uncorroborated testimony cannot satisfy the burden of showing "reasonable diligence" is well taken. *Kendall v. Searles*, 173 F. 2d 986, 36 CCPA 1045, 81 USPQ 363 (1949). Cricchi did not present any documentary evidence showing specific acts at specific times directed at a reduction to practice of the invention of the counts. Instead, he relies on time cards showing work charged to four project numbers

⁷ Although appellants did not raise this issue in their main brief before the board, they did so in their Request for Reconsideration, and the board considered the argument in reaching its decision. Thus, the issue is properly before the court. Cricchi is incorrect in labeling the argument an improper new issue.

⁸ Indeed, Cricchi admits this in his brief.

for this purpose. However, the time cards are not self-explanatory, and Cricchi's is the only testimony that undertakes to explain the work performed. Nothing in the record corroborates Cricchi's explanation. As pointed out above, testimony of one of Cricchi's own witnesses contradicts his allegation that time charged to the project numbers was directed solely at a reduction to practice of the invention of the counts.

Accordingly, we hold that the time card charges of record and Cricchi's uncorroborated testimony concerning the work covered thereby do not satisfy Cricchi's burden of proving "reasonable diligence" during the period from October 1970 to September 1971.

3. Motion to Tax Costs

Naber has moved to assess printing costs against Cricchi for the portions of the transcript requested by Cricchi. These cover all of the testimony of Naber's witnesses. Cricchi states that his reason for including such testimony in the transcript was that Naber's Notice and Reasons of Appeal indicated that Naber would argue Cricchi's date of conception; that "[i]f Cricchi's date of conception was to be argued, this automatically raises the question of when did Naber et al. enter into the field."

[6, 7] Because Cricchi argued the issue of Naber's entry into the field before the board, it was not necessary for him to file a cross-appeal to preserve the issue for argument before this court. *Clauss v. Foulke*, 379 F.2d 586, 54 CCPA 1514, 154 USPQ 85 (1967). However, if that issue were to be argued before this court, it would have been Cricchi who would have raised the issue, Naber not having questioned the board's finding of Naber's date of entry into the field. Since the costs of printing the material necessary for the court to make a determination of the issues raised by appellee are normally as-

sesed against appellee, *Meitzner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (Cust. & Pat. App.), cert. denied, — U.S. —, 98 S.Ct. 174, 54 L.Ed.2d 124 (1977), Naber's Motion to Tax Costs to appellee Cricchi is granted.

The decision of the board awarding priority to Cricchi on counts 1-4 is *reversed*.

REVERSED.